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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/080,458

02/22/2002

Stanley Pohl

CP-1235

8402

27752

7590

10/06/2003

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,458

Applicant(s)

POHL, STANLEY

Examiner

Alexander Markoff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/22/02-5/9/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. It is noted that the instant claims are directed to distinct inventions, which can properly restricted. No restriction requirement is made this time because the same prior art is applied to claims directed to these distinct inventions. However, the applicants are advised, that if the claims would be amended to put a serious burden on the examiner in further examination, such requirement can be issued.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-16 are indefinite and incomplete because of the following:

Claim 9 requires incorporating a phosphate ester surfactant of formula I, but fails to recite to where this surfactant has to be incorporated.

The clause "may be" in claim 9 makes the claims indefinite because renders the scope of the claims unascertainable.

Claims 17-24 are indefinite because claim 17 requires a film formed by the composition being more easily removed from the surface, but fails to recite a comparative basis.

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 9, 15-17 and 23-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/080,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

The difference between the instant claims and the claims of the copending application is that the claims of the instant application recite an anionic amphiphilic polymer, while the claims of the copending application recite an acrylate copolymer.

Thus the scope of the claims of copending application is inside of the scope of the claims of the instant application.

6. Claims 8, 10-14, 18-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/080,459 in view of the state of the prior art admitted by

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the applicants in the specification (pages 1-3 and 7) and Dias et al (US Patent No 6,432,147, WO 98/27945).

The difference between the claims of the instant application and the claims of the copending application is that the claims of the instant application recite the specific acrylate copolymers, when the claims of the copending application recite a genus of acrylate copolymers.

On the other hand, the applicants admitted in the specification that all the specifically claimed copolymers are commercially available. Moreover, the admitted prior art and Dias et al teach that at least some of the claimed copolymers were conventional parts of the hair coloring compositions comprising the same ingredients as recited by the claims.

It would have been obvious to an ordinary artisan to use commercially available species of the disclosed genus in the method and the composition of the copending application with a reasonable expectation of adequate results in order to have a reliable source of the chemicals because these species were conventionally used in the similar compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al (US Patent No 6,432,147, WO 98/27945).

The relevant parts are cited using the US Patent.

Dias et al teach a hair coloring composition comprising the claimed ingredients: hydrogen peroxide in the claimed range (see at least column 5, line 64 – column 6, line 12; column 6, lines 45-53);

claimed polymer in the claimed range (see at least column 25, lines 50-67);

claimed phosphate ester surfactant (see at least column 27, lines 41-53);

claimed cosolvents (see at least column 26, lines 1-24); and

water (see at least column 26, lines 1-5).

Dias et al teach the claimed pH. See at least Abstract, columns 5 and 10, claims 1-2.

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Dias et al does not specifically teach a range for the concentration of the claimed surfactant. However, in all the examples surfactants are presented in the range 1.5-1.7%. This concentration is in the claimed range.

It would have been obvious to an ordinary artisan at the time the invention was made to provide any of the disclosed surfactants in this range with reasonable expectation of adequate results because this range is recommended by the reference.

10. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the prior art admitted by the applicants in the specification (pages 1-3) in view of Dias et al (US Patent No 6,432,147, WO 98/27945).

The applicants admitted in the specification that thickened hair dye compositions comprising acrylate copolymers leave a polymeric film on the stainless steel equipment.

The applicants also admitted that this film is conventionally removed by a hot alkaline solution.

Dias et al teaches a hair coloring composition, which is thickened by acrylate copolymers.

It would have been obvious to an ordinary artisan at the time the invention was made that such composition would leave the polymer film disclosed by the admitted prior art.

It would have been obvious to an ordinary artisan at the time the invention was made to remove this film by a conventional prior art method, i.e. by cleaning with an alkaline solution with reasonable expectation of adequate results.

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The composition of Dias et al comprises the claimed ingredients and has the claimed pH.

Thus the prior art cleaning method applied to the equipment used with the composition of Dias et al would meet the claimed limitations.

As to claims 15 and 16:

The admitted prior art does not disclose the pH of the used alkaline solution and fails to disclose a cleaning pressure.

However, the pH (concentration) of the cleaning solution and the pressure of the applied cleaning solution are result effective variables.

It would have been obvious to an ordinary artisan at the time the invention was made to find an optimum pH and an optimum application pressure by routine experimentation.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents No 6,022,381, 6,309,426 and 6,398,821 are cited to show the state of the prior art with respect to hair coloring compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on 703-308-4333. The fax phone

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number for the organization where this application or proceeding is assigned is (703)
872-9306.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is 703--308-
0651.



Alexander Markoff
Primary Examiner
Art Unit 1746

am

ALEXANDER MARKOFF
PRIMARY EXAMINER